

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the present amendments and following discussion, is respectfully requested.

Claims 1-23 are pending; Claims 4 and 16 are amended; and no claims are newly added or cancelled herewith. It is respectfully submitted that no new matter is added by this amendment.

In the outstanding Office Action, the specification was objected to; Claim 19 was objected to; Claims 4, 5, 16, and 17 were rejected under 35 U.S.C. § 102(b) as anticipated by Kobayashi (U.S. Pat. No. 5,144,615); and Claims 1-3, 6-13, and 18-22 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kobayashi in view of Arioka et al. (U.S. Pat. Pub. 2002/0034604, hereafter Arioka).

Applicants thank Primary Examiner Miller and Examiner Agustin for the interview granted Applicants' representative on February 3, 2004. During the interview, it was agreed that filing a certified English translation of the priority documents would overcome the outstanding rejection under 35 U.S.C. § 103. Accordingly, Applicants have filed herewith certified English translations of JP 2000-212512 (filed July 13, 2000), JP 2001-053390 (filed February 28, 2001), and JP 2001-086813 (filed March 26, 2001).

As the Applicants have perfected priority, thereby removing Arioka (which has a U.S. filing date of July 3, 2001) from consideration, it is respectfully requested that the outstanding rejection of Claims 1-3, 6-13, and 18-22 be withdrawn.

Regarding the rejection of Claims 4, 5, 16, and 17 under 35 U.S.C. § 102(b) as anticipated by Kobayashi, that rejection is respectfully traversed.

Independent Claims 4 and 16 recite that a timing of detecting a marked edge of each of the recording marks and a timing of detecting a reflection light intensity of each of the recording marks are different. As illustrated, for example, in Figure 3 and described in the

non-limiting description at page 25, the signal intensities may be sampled at a timing delayed by one clock signal from a leading edge. As a result, reproducing signals can be identified as being at one of four levels.¹

During the interview, it was indicated that the Examiner's position is that different timings are inherent in the teachings of Kobayashi.

However, as set forth in MPEP § 2112, "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (emphasis in original). Specifically,

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would so recognized by persons of ordinary skill in the art. Inherency, however, may not established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

Moreover,

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In the outstanding Office Action, and during the interview, no technical reasoning was provided to support the assertion that a timing of detecting a marked edge of each of the recording marks and a timing of detecting an intensity of a reflection light from each of the recording marks are different.

¹ Specification, pages 25-26.

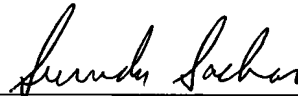
Accordingly, as there is no disclosure or suggestion of the different timings and no technical reasoning has been provided to support the assertion of inherency, it is respectfully submitted that the outstanding Office Action has failed to satisfy the burden set forth in MPEP § 2112. It is therefore respectfully requested that this rejection be withdrawn.

With regard to the objection to Claim 19, Claim 19 has been amended to depend from Claim 18. Likewise, with regard to the objections to the specification, the noted informalities have been amended. It is therefore respectfully requested that these objections be withdrawn.

Consequently, in view of the foregoing discussion and present amendments, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

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